

REMARKS

Claims 1-111 are now pending in the application. Claims 39-109 and 111 have been allowed. Claims 1-8, 13-15, 17-19, 21, 23-27, 31, 34, and 110 have been rejected. claims 9-12, 16, 20, 22, 28-30, 32, 33, and 35-38 have been objected to. Applicants respectfully request reconsideration of the rejected claims in view of the terminal disclaimer accompanying this Reply and the remarks concerning the remaining rejection.

Rejection for Obviousness-Type Double Patenting

Claims 1-6 and 8 have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-6 and 8 of Kingman et al. U.S. Patent No. 6,140,392. Applicants submit herewith a terminal disclaimer for any patent issuing from the present application with regard to the Kingman patent. Applicants believe the terminal disclaimer overcomes this rejection. Reconsideration and allowance of the claims is respectfully requested in light of the terminal disclaimer.

Statement of Obligation to Assign

The invention of the present application and the invention of Kingman et al. U.S. Patent No. 6,140,392 were, at the time the later invention was made, both owned by or subject to an obligation of assignment to Flint Ink Corporation. Applicants note the assignments recorded January 21, 2002 at Reel/Frame 012524/0557 for this application and recorded November 30, 1998 at Reel/Frame 9650/0589 for the Kingman et al. patent.

Rejection Under 35 U.S.C. § 102(b) over Krishnan et al.

Claims 1, 3-6, 15, 17-19, 21, 23-27, 31, 34, and 110 have been rejected under section 102(b) as anticipated by the Krishnan et al. patent, U.S. 5,778,789. Applicants respectfully traverse the rejection and request reconsideration of the claims.

The rejected claims are drawn to a lithographic ink composition comprising a continuous phase comprising a hydrogen bonding vinyl polymer and an emulsified phase comprising, water, liquid polyol, or both.

The Krishnan patent, on the other hand, has a continuous phase of water in which a polymeric material is emulsified. Col. 3, lines 23-45 ("25 to 60 wt. %, preferably 35 to 50 wt. %, based on the weight of the ink, of water *which is present as a continuous phase in the ink*") (emphasis added); Example 1 (describing a latex-based ink). The Krishnan lithographic ink must be used with a special, silicone-coated plate (the so-called "Toray" plate). Col. 2, lines 23-30; Example 1. As the present application explains in the Background (at paragraph 5), The silicone-coated plates are expensive and require additional expensive modifications to the press. In contrast, the present invention having a continuous ink phase emulsifying the water and/or polyol phase can be printed on lithographic presses using conventional plates and without expensive press modifications.

None of the rejected claims are anticipated by the Krishnan patent because the Krishnan patent does not disclose a lithographic ink composition comprising a continuous phase comprising a hydrogen bonding vinyl polymer and an emulsified phase comprising, water, liquid polyol, or both. Accordingly, Applicants respectfully request withdrawal of this rejection and reconsideration and allowance of the claims.

Rejection Under 35 U.S.C. § 103(a) over Krishnan et al. in view of JP 08108662

Claims 7 and 13 have been rejected as unpatentable over the Krishnan et al. patent, U.S. 5,778,789 in view of JP 08108662. Applicants respectfully traverse the rejection and request reconsideration of the claims.

Claims 7 and 13 incorporate the limitations of claim 1, which is patentable over the Krishnan patent. The Office Action cites the Japanese reference for allegedly disclosing a lithographic ink using citric acid or tartaric acid to control pH of the ink and using alkali metal salt of nitric, boric, phosphoric, or sulfuric acid for easier removal of the ink from the printing plate. Such additional disclosure, however, does not overcome the deficiencies of the primary Krishnan reference.

Applicants submit, therefore, that the rejected claims are not obvious over the combination of cited references. Accordingly, Applicants respectfully request withdrawal of this rejection and reconsideration and allowance of the claims.

Rejection Under 35 U.S.C. § 103(a) over Krishnan et al. in view of Britton, Jr.

Claim 14 has been rejected as unpatentable over the Krishnan et al. patent, U.S. 5,778,789 in view of the Britton, Jr. patent, U.S. 5,024,700. Applicants respectfully traverse the rejection and request reconsideration of the claims.

As in the case of claims 7, and 13, claim 14 is patentable over the cited references because the primary reference of the Krishnan patent fails to disclose a lithographic ink comprising a continuous phase comprising a hydrogen bonding vinyl polymer and an emulsified phase comprising, water, liquid polyol, or both. Therefore, claim 14 is patentable over the combination regardless of whether the Britton, Jr. patent

discloses the use of triethanolamine or whether or not the motivation alleged in the Office Action would hold for the Krishnan ink or be sufficient to one of ordinary skill in the art.

Applicants submit the rejected claims are not obvious over the cited references. Accordingly, Applicants respectfully request withdrawal of this rejection and reconsideration and allowance of the claims.

Conclusion

Applicants note with appreciation the Examiner's determination that claims 39-109 and 111 are allowable and that claims 9-12, 16, 20, 22, 28-30, 32, 33, and 35-38 are drawn to allowable subject matter.

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Anna M. Budde
Anna M. Budde
Registration No. 35,085

December 4, 2003
Harness, Dickey & Pierce, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600